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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,414

04/19/2006

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03/21/2011

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1782

NOTIFICATION DATE

DELIVERY MODE

03/21/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,414	<b>Applicant(s)</b> WATANABE	
	<b>Examiner</b> WALTER B. AUGHENBAUGH	<b>Art Unit</b> 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

#### ***Acknowledgement of Applicant's Amendments***

1. The amendments made in claim 1 in the Amendment filed December 17, 2010 have been received and considered by Examiner.

### **WITHDRAWN OBJECTION**

2. The new matter objection to the specification has been withdrawn due to Applicant's amendment in claim 1 in the Amendment filed December 17, 2010.

### **WITHDRAWN REJECTIONS**

3. All 35 U.S.C. 112, first and second paragraph, rejections made of record in the previous Office Action mailed September 17, 2010 have been withdrawn due to Applicant's amendments in claim 1.

### **NEW OBJECTION**

#### **Specification**

4. The amendment filed December 17, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the condition that  $(Z-y-t) > t$  that was added to

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claim 1 in the amendment filed December 17, 2010. See 35 USC 112, first paragraph rejection of claims 1 and 2 made of record below.

Applicant is required to cancel the new matter in the reply to this Office Action.

## **NEW REJECTION**

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regard to claim 1, the specification does not provide support for the condition that  $(Z-y-t) > t$  that was added to claim 1. While the geometries of the components shown in Fig. 1 do fall within this condition, there is no support in the specification as originally filed for the concept of  $(Z-y-t) > t$ . Even though the components shown in Fig. 1 do fall within this condition, this condition covers a range of structures much broader than what is shown in Fig. 1, and there is no support in the specification as originally filed for the broad range of structures that would fall within the condition of  $(Z-y-t) > t$ .

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because it depends upon claim 1.

## **UPDATED REJECTIONS**

### **Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al. (USPN 4,816,308).

In regard to claim 1, Shimizu et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 3, and alternatively, Fig. 4. In regard to the last four lines of the claim, Shimizu et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 3 of Shimizu et al. with Applicant's Fig. 1.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Collette et al. (USPN 5,759,653).

In regard to claim 1, Collette et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 4, and alternatively, Fig. 5. In regard to the last four lines of the claim, Collette et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig.

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4 and 5 of Collette et al. with Applicant's Fig. 1. Note that the second resin does not extend to the top of the resin mass shown in Fig. 4 and 5 of Collette et al.

In regard to claim 2, the recited distance of Collette et al. is 0 at the lowest point of the preform. See, for example, Fig. 4, and alternatively, Fig. 5.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604) (English abstract filed with IDS).

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See English abstract text, and Fig. 3D has a structure that corresponds to the structure recited by “(Z-y-t) > t”. Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures of English abstract with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

### **Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (USPN 4,816,308).

In regard to claim 2, Shimizu et al. teach the resin mass as discussed above in regard to claim 1. While Fig. 3 in particular appears to show a distance that corresponds to the claimed distance that is close to, if not about, 10%, Shimizu et al. teach that the relative amount of the resins A and B may vary widely and that it is desirable to achieve good transparency (col. 4, lines 37-57), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have varied the thickness of the bottom layer of resin A, such as to decrease its thickness in order to achieve the desired degree of transparency, depending on the particular desired end results, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). MPEP 2144.05 II.B. Since Resin B is the barrier layer, minimizing the thickness of the layers of resin A will not substantially affect the barrier properties of the container from which the resin mass is formed if at all.

### **Response to Arguments**

13. Applicant's arguments in regard to the 35 U.S.C. 102 rejections of the claims based on Shimizu et al. (USPN 4,816,308), Collette et al. (USPN 5,759,653) and Kuwabara et al. (JP 03-

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234604 and English abstract filed with IDS) made of record in the previous Office Action have been fully considered but are not persuasive.

All references cited in the rejections anticipate the claimed molten resin mass. Applicant argues that the references do not teach molten resin masses because they teach preforms.

In the previous Office Action, it was stated that “preforms correspond to molten resin masses”. This statement should be clarified: during the process of forming the preforms taught by Shimizu et al. (USPN 4,816,308), Collette et al. (USPN 5,759,653) and Kuwabara et al. (Fig. 3D), the resin mass that ultimately is solidified into the preform is a molten resin mass having the structural characteristics that are recited in claim 1 (and 2, as identified above). A molten resin mass in the shape of the preform (and having components having the claimed structural features) is necessarily an intermediate product in the process of the formation of the preform. Before the preform solidifies into a preform, it is a molten resin mass in the shape of a preform (having components having the claimed structural features). For example, note that Kuwabara et al. show various stages of forming the resin molten mass into a preform (a solidified, preform in final form) in Fig. 3A-3E. Therefore, if the components of the preform have structural features that correspond to the claimed structural features, a molten resin mass having those same structural features necessarily existed during the process of formation of the preform. This is why a comparison between the preforms of the art and the claimed molten resin mass is appropriate. Also note that Fig. 3D of Kuwabara et al. shows an intermediate form of the molten resin mass used to form the preform.



### **Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /

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